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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,212	10/30/2003	David R. Hennings	NSL-501	2780

7590

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EXAMINER

SHAY, DAVID M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/699,212

Applicant(s)

Hennings et al

Examiner

J. J. J.

Group Art Unit

3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE —3— MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on March 26, 2004
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-24 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-24 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13, 16, 18-20 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is unclear as there are no method steps positively recited therein. In claim 6 it is unclear what further limitation is intended to be recited given that claim 1 already requires the absence of blood. Claim 16 is indefinite as it unclear what further structure is to be implied by reciting the effect of the anesthesia on the tissue and "the anesthesia" lacks positive antecedent basis. Claim 18 is indefinite as it is unclear what structure not inherent in a catheter is intended to be inferred. Claim 24 is incomplete as there is not enough structure in the fiber itself to perform the function of thermal sensing.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman et al ('084) in combination with Dew et al. Goldman et al ('084) teaches a method as claimed, but does not specify a wavelength. Dew et al teach the desirability of using 1.3 micron radiation to treat tissue. It would have been obvious to the artisan of ordinary skill to employ the wavelength of Dew et al in the method of Goldman et al ('084), since Goldman et al ('084) teach no particular wavelength, thus producing a method such as claimed.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman et al ('084) in combination with Dew as applied to claims 1, 2, 6, and 7 above, and further in view of Roth et al. Roth et al teach employing pull back rate as claimed, noting that the desired rate is dependent on the laser energy. It would have been obvious to the artisan of ordinary skill to employ a pull back rate as claimed, since there are known in the art and provide no unexpected result and to initiate pulling prior to energy application, since the problem of tissue adhesion is notorious in the art official notice of which is hereby taken, thus producing a method such as claimed.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman et al ('084) in combination with Dew et al as applied to claims 1, 2, 6, and 7 above, and further in view of Conn et al. Conn et al teach a diffusing tip as claimed, it would have been obvious to the artisan of ordinary skill to employ a tip as taught by Conn et al, since this would provide a uniform distribution of light and would prevent over or under treatment of tissue, thus producing a method such as claimed.

Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman et al ('084) in combination with Dew et al as applied to claims 1, 2, 6 and 7 above, and further in view of Makower et al. Makower et al teach controlling the heating of tissue using infrared sensing techniques. It would have been obvious to the artisan of ordinary skill to employ the temperature sensor of Makower et al in the method of Goldman et al ('084) since these are equivalents, as taught by Makower et al, thus producing a method such as claimed.

Claims 14-18 and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makower et al in combination with Roth et al and Dew et al. Makower et al teach a device as

claimed except the particular laser wavelength and the pull back mechanism. Dew et al teach a wavelength as claimed for treating tissue. Roth et al teach a pull back mechanism providing the claimed rate. It would have been obvious to the artisan of ordinary skill to employ the laser wavelength of Dew et al in the device of Makower et al, since Makower et al teach the use of an Nd:YAG laser and to employ the pull back mechanism of Roth et al, since this enables uniform treatment along a luminal surface, as taught by Roth et al, thus producing a device such as claimed.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Makower et al in combination with Dew et al and Roth as applied to claims 14-18 and 20-24 above, and further in view of Conn et al. Conn et al teach a diffusing tip as part of an introducer device for a fiber. It would have been obvious to the artisan of ordinary skill to include the diffuser of Conn et al in the device of Makower et al, since this reduces problems due to breakage, as taught by Conn et al, thus producing a device such as claimed.

Any inquiry concerning this communication should be directed to David Shay at telephone number 308-2215.



Shay/DI

June 14, 2004